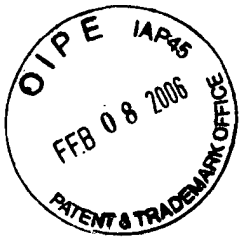


PATENT: **Mail Stop AF**

Customer No. 22,852
Attorney Docket No. 08011.3010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
John DeMayo et al.	Group Art Unit: 3622
Application No.: 09/711,261	Examiner: CHAMPAGNE, Donald
Filed: November 10, 2000	
For: APPARATUS AND METHOD FOR HYPERLINKING SPECIFIC WORDS IN CONTENT TO TURN THE WORDS INTO ADVERTISEMENTS	Confirmation No.: 6688

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections in the Final Office Action mailed on October 5, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005, and a Petition for Extension of Time.

Remarks follow in the next section of this paper.

REMARKS

Applicants request a pre-appeal brief review of rejections set forth in the Final Office Action of October 5, 2005. Such a review is proper because (1) the application has been at least twice rejected; (2) Applicants have concurrently filed a Notice of Appeal (prior to filing an Appeal Brief); and (3) this Pre-Appeal Brief Request for Review is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

Claims 1-32 are pending in this application. In the Advisory Action mailed January 17, 2006, the Examiner withdrew the rejection of claims 1-30 under 35 U.S.C. § 112, second paragraph, and entered the proposed amendments submitted in the Amendment After Final of January 5, 2006.

Applicants respectfully traverse the remaining rejections and submit that a clear error exists in the Examiner's rejections. The error is that the rejections cannot stand because the applied references, individually or in combination, do not teach or suggest an apparatus for hyperlinking specific words in content to turn the words into advertisements including, among other things, "means for providing a hypertext anchor to *convert at least one existing advertiser-chosen word present in a content file into an advertisement* by linking said at least one advertiser-chosen word to said advertiser web page," as recited in claim 1 (emphasis added).

Claims 1, 2, 4-6, 9, 10, 12, 13, 21, 24, and 31 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bull et al. (U.S. Patent No. 5,995,943) In the Final Office Action, the Examiner contends the "chosen word(s) present in a context file, *Holiday Inns on the West Coast*, are taught at col. 15, lines 39-42" of Bull (emphasis in original). See page 4. Applicants disagree that Bull teaches "convert[ing] at least one

existing advertiser-chosen word present in a content file into an advertisement," as recited in claim 1. Instead, col. 15, lines 39-42 of Bull states:

> As an example, if the user accesses web pages for "Holiday Inns on the West Coast", the insertion mechanism would be established to automatically insert ads for "Hilton Inns on the West Coast."

In other words, Bull teaches that pre-prepared ads for "Hilton Inns on the West Coast" are inserted into a web page after it is determined that a user has accessed a web page for "Holiday Inns on the West Coast." However, this teaching of Bull does not constitute a conversion of an existing word in a content file into an advertisement. Rather, according to Bull, an "ad is inserted based on the content of the existing web page being read" and is inserted as a new piece of information (emphasis added). For example, Fig. 6 of Bull shows an arrow labeled "GET AD TO INSERT," indicating that the ad is retrieved from advertising database 250. After retrieving the ad, the Bull system will then "cause an advertisement/coupon to be added into the display" (emphasis added). See col. 12, lines 15-16. While Bull teaches that new page content in the form of an ad is added to the display, that teaching does not constitute converting an existing word in the content file into an advertisement. Accordingly, Bull does not teach at least the claimed "means for providing a hypertext anchor to *convert at least one existing advertiser-chosen word present in a content file into an advertisement* by linking said at least one advertiser-chosen word to said advertiser web page," as recited in claim 1 (emphasis added). Therefore, the rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by Bull is improper and the rejection of claim 1, and claims 2 and 4-6, which depend from claim 1, should be withdrawn.

The Examiner rejected independent claims 9, 21, and 24 under the same reasoning as claim 1. These claims, while of a different scope, include recitations similar to allowable claim 1. Accordingly, the rejection of claims 9, 21, and 24, and claims 10 and 12-13, which depend from claim 9, should also be withdrawn.

Independent claim 31 recites a method including, among other steps, "*displaying a description* of the advertiser web page when a mouse pointer is positioned over the hyperlink" (emphasis added). Bull does not teach at least this element of claim 31. Instead, Bull teaches positioning a mouse pointer over a URL link in order to click on the link. See col. 14, lines 50-52. Therefore, the rejection of claim 31 should be withdrawn.

Claims 3, 7, 11, 14, 15, 22, and 25 were rejected under 35 U.S.C. § 103(a) as obvious over Bull. Claims 3 and 7 depend from claim 1; claims 11, 14, and 15 depend from claim 9; claim 22 depends from claim 21; and claim 25 depends from claim 24. As discussed above, Bull does not teach every element of independent claims 1, 9, 21, and 24. Accordingly, Bull does not disclose or suggest all elements of claims 3, 7, 11, 14, 15, 22, and 25, at least due to their dependence from allowable claims.

Claims 8, 16, 23, and 26 were rejected under 35 U.S.C. § 103(a) as being obvious over Bull in view of Kirsch. Claim 8 depends from claim 1, claim 16 depends from claim 9, claim 23 depend from claim 21, and claim 26 depends from claim 24. As discussed above, Bull fails to teach or suggest every element of claims 1, 9, 21, and 24 and their dependent claims. Furthermore, Kirsch does not teach the claim elements missing from Bull. Accordingly, the references, individually or in combination, fail to teach or suggest all of the elements of claims 8, 16, 23, and 26.

Claims 17-19, 27-29, and 31 were rejected under 35 U.S.C. § 103(a) as being obvious over Bull in view of Murray. As discussed above, Bull does not disclose or suggest at least all of the elements of independent claims 17, 27, and 31. Furthermore, Murray does not make up for the deficiencies of Bull. Accordingly, the rejection of claims 17, 27, and 31 and dependent claims 18-19 and 28-29 should be withdrawn.

Claims 19, 20, 29, 30, and 32 were rejected under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and Kirsch. Claims 19 and 20 depend from independent claim 17. Claims 29 and 30 depend from independent claim 27. Claim 32 depends from independent claim 31. As discussed above, Bull in view of Murray does not disclose or suggest all elements of claims 17, 27, and 31. Nor does Kirsch make up for the deficiencies of Bull and Murray. Accordingly, claims 19, 20, 29, 30, and 32 are allowable at least due to their dependence.

CONCLUSION

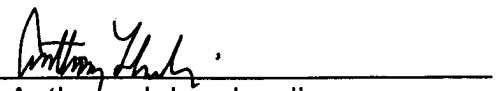
In view of the foregoing, Applicants respectfully request a pre-appeal brief review of the rejections in the Final Office Action mailed on October 5, 2005. Pending claims 1-32 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 8, 2006

By: 
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